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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------|------------------|
| 10/729,234 | 12/05/2003 | Roger Thomas | P-US-PR-1115 | 9211 |
| 7590 | 05/18/2005 | | EXAMINER | |
| Michael P. Leary Group Patent Counsel Black & Decker Corporation 701 E. Joppa Rd., Mail Stop TW199 Towson, MD 21286 | | | SELF, SHELLEY M | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3725 | |
| | | | DATE MAILED: 05/18/2005 | |

Please find below and/or attached an Office communication concerning this application or proceeding.

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| | | |
|------------------------------|------------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/729,234 | THOMAS, ROGER |
| | Examiner | Art Unit |
| | Shelley Self | 3725 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-13 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 05 December 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>12/5/03</u> | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

Applicant is reminded that in order for a patent issuing on the instant application to obtain the benefit of priority based on priority papers filed in parent Application No. GB0308565.1 under 35 U.S.C. 119(a)-(d) or (f), a claim for such foreign priority must be timely made in this application. To satisfy the requirement of 37 CFR 1.55(a)(2) for a certified copy of the foreign application, applicant may simply identify the application containing the certified copy.

Applicant's claim for foreign priority is based on four (4) foreign applications, however only copies of three of the foreign applications have been received. Accordingly a copy of the fourth application, GB0308565.1 is necessary to comply with 35 U.S.C. 119(a)-(d) or (f).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-10 and 13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 7, 10 and 12-14 of copending Application No. 10/729233. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the presently presented application are merely reworded versions of those submitted in the co-pending application. For example, claim 1 of the presently presented application is a combination of claims 1, 3-5 and 7. The claims of the presently presented application fail to set forth patentably distinguishing structure from that presented in co-pending application 10/729233 and would be obvious over those of the co-pending application. Accordingly, the presently presented claims are not patentably distinct from the claims of the co-pending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Drawings

The drawings are objected to under 37 CFR 1.83(a) because they fail to show *plastic cap...is used to seal up the other aperture* (pg. 4, line 22) and *a spring biases the curved pivotal flap to the lower position indicated by reference letter Q* (pg. 7, lines 5, 6) as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d).

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the *motor, airflow generator, (clm. 1) first and second exhaust apertures* (clm. 2), the *resiliently biased flap* (clm. 6) and *biasing*

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means/spring (clms 7, 8) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: *I2* and *T*.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character “52” has been used to designate both recess and expulsion aperture (pg. 5, line 16).

All of the drawings should be reviewed to ensure proper annotation of elements and references to such within the written disclosure.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) and/or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the examiner does not

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accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities:

- Page 4, line 27, “sidewaysly” is not understood
- Page 7, line 17, “...*internal structure of the body 2 to of the planer...*” is not understood
- Page 7, line 13, “...*pivotal flap is its downward position...*” is not understood

Additionally, the Abstract is objected to, the reference character “6”, line 4 should be removed from the Abstract.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. With regard to claim 1, neither the specification nor the drawings provide support for an exhaust aperture as set forth in the claim. In fact, the specification makes no reference to the term, “exhaust aperture”.

Therefore, a clear understanding of the exhaust aperture cannot be determined from the written description. Further the specification defines an “expulsion aperture”, it is not clear as to whether the exhaust aperture and the expulsion aperture terms are being used interchangeably or if the two are separate elements of the claimed invention. Clarification is required.

Regarding claims 2 and 3, the specification fails to describe in detail the arrangement of a first and second exhaust aperture.

With regard to claim 10, neither the specification nor the drawings provide support for a “*...third direction of the nozzle airflow and the first direction of the debris intersect at an acute angle*”

Accordingly, the disclosure appears to be inadequate.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are particularly confusing in that they recite structure not positively supported within the specification or drawings. With regard to claim 1, there is no antecedent basis within the disclosure for the term, “exhaust aperture”. With regard to claim 2, the claim states, “...a first exhaust aperture and...a second exhaust aperture...” as noted above no such aperture(s) are positively supported in the specification.

Claim 10, is particularly confusing, "the expulsion aperture is recited several times within the claim, there is also reference to, "the aperture", it is not clear as to whether "the aperture" refers to the exhaust aperture (parent clm. 1) or the expulsion aperture. Clarification is required.

There is no antecedent basis for the following:

"the biasing means" (clm 7)

"the expulsion aperture" (clm. 10, lines 2, 4, 5' clm. 11, line 2)

"the aperture"

Regarding claim 7, the word "means" is preceded by the word(s) "biasing" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967). Examiner suggests, --means for biasing—

A clear understanding of the scope of the claim and the protection desired could not be determined. Accordingly the equivalents of the prior art could not be ascertained, thus no prior art has been applied.

All of the claims should be reviewed for proper support, clarity, definiteness and antecedent basis concerns to facilitate a clear understanding of the claimed invention.

Conclusion

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shelley Self whose telephone number is (571) 272-4524. The

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examiner can normally be reached Mon-Fri from 8:30am to 5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Derris Banks can be reached at (571) 272-4419. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular and After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SSelf
May 12, 2005



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